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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91196299
Party	Defendant Digitalmojo, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

## Opposition No. 91196299 (Parent)

CONNECT PUBLIC RELATIONS, INC.  
Opposer,

V.

DIGITALMOJO, INC., Applicant

**APPLICANT’S/PETITIONER’S  
REPLY IN SUPPORT OF ITS  
MOTION TO COMPEL  
SUPPLEMENTAL RESPONSES**

**Cancellation No. 92054395**

**Cancellation No. 92054427**

DIGITALMOJO, INC.,  
Petitioner,

V.

CONNECT PUBLIC RELATIONS, INC.  
Respondent.

DigitalMojo, Inc., Applicant and Petitioner in these consolidated cases (“DigitalMojo”) submits this Reply and Memorandum in support of its: Motion to Compel Supplemental Responses to: 1. Petitioner’s Interrogatories, Set One and Set Two, and 2. Petitioner’s Requests for Admissions, Sets One and Two, and for Leave to Serve Additional Discovery (the “Motion to Compel”).

DigitalMojo addresses the points raised by Opposer and Respondent Connect Public Relations, Inc. (“Connect”) in the order in which they are raised in Connect’s Memorandum in Opposition to DigitalMojo’s Motion to Compel (Connect’s “Response”).

## **I. INTRODUCTION**

Connect has begun with an “introduction” about DigitalMojo’s failure to comply with “basic procedural rules” of the Federal Rules of Civil Procedure and the TBMP. However, Connect elaborates its discussion on these points in two succeeding sections of its Response. DigitalMojo will therefore address these points below.

## **II. CONNECT SHOULD BE COMPELLED TO SUBSTANTIVELY RESPOND TO DIGITALMOJO’S REQUESTED DISCOVERY, EITHER ON THIS MOTION TO COMPEL, OR ON LEAVE TO SERVE SUCH DISCOVERY**

Connect correctly points out that DigitalMojo is requesting additional discovery in this Motion to Compel because of the unusually numerous or complex issues involved in these cases. DigitalMojo has pointed out in its moving paper the timing of the early discovery served in, and the joinder of, these cases. The joinder of DigitalMojo’s Petitions to Cancel two of Connect’s registrations has raised issues which, according to Connect, could not be previously raised. As but one example, we may note a representative question taken from PETITIONER’S REQUESTS FOR ADMISSIONS, SET ONE:

*REQUEST FOR ADMISSION NO. 127 - Admit the documents numbered CPR 000375 - CPR 000376 refer to the registration of the mark CONNECT PUBLIC RELATIONS, registered under number 2373504, and that all goods and/or services “listed in the existing registration” comprise: “Marketing and market research and consulting services; public and media relations services and sales promotion services.”*

To this question, Connect has objected, in part, with the following statement: “Opposer objects to this request as being irrelevant as Opposer’s use of its marks is not at issue.” Exhibit B to the Motion to Compel. Of course, Connect’s use of its marks is very much at issue after the joinder of DigitalMojo’s petition to cancel, and Connect should not now be heard to say DigitalMojo is not entitled to ask questions about Connect’s use of its marks when Connect would not answer those same questions earlier claiming its registrations were “not at issue.”

As to whether DigitalMojo should have filed a motion for leave to propound additional discovery, DigitalMojo has in its moving paper requested precisely such leave. DigitalMojo could not know until it received Connect's responses that such responses would be insufficient and evasive, nor did it know Connect would object to DigitalMojo discovery; DigitalMojo assumed Connect would in good faith attempt to answer DigitalMojo's discovery with reasonable, substantive, responses. Given Connect's evasions in its responses received after close of discovery, and the additional questions presented in its Petitions, and the need for responses to questions such as those set forth above and in its discovery necessary to decide these cases on the merits, DigitalMojo thinks such leave should be granted.

As to whether DigitalMojo's Motion to Compel was brought within a reasonable time, DigitalMojo should note again here that, as to DigitalMojo's Requests for Admissions, Connect did not merely fail to respond to DigitalMojo's original set of Requests (served prior to the joinder of DigitalMojo's Petitions), Connect objected to many of those Requests saying "Opposer objects to this request as being irrelevant as Opposer's use of its marks is not at issue." We might argue about whether those of DigitalMojo's Requests answered in this way were irrelevant, but as a technical matter Connect was correct that its registrations were "not at issue" at the time, and it may have been futile for DigitalMojo to argue about Connect's objections of this character.

However, after the joinder of these Petitions into this opposition, the most reasonable and economical method of dealing with questions to which this kind of objection was asserted is to serve the Requests containing those questions again. And while Connect points out DigitalMojo has cited no authority that would allow it to re-serve discovery requests, Connect has cited no authority which suggest DigitalMojo cannot re-serve discovery requests. Connect has simply opined DigitalMojo has inappropriately re-served its Requests for Admission "Instead of following proper procedure..."

As to whether DigitalMojo served its discovery "within a reasonable time...after the service of the response believed to be inadequate...", Connect does not contend that DigitalMojo failed to file this Motion to Compel within a reasonable time after it received Connect's responses served on April 21, 2014 (for discovery served by DigitalMojo prior to the close of discovery). Connect merely contends that "...ii. the discovery period is closed..." Response Page 6, first full paragraph. Later in Connect's Response, at the bottom of page 7, Connect again

stresses that DigitalMojo filed its Motion to Compel “...and after discovery has closed...” (emphasis by Connect). Connect cites no authority for the proposition that DigitalMojo may not file its Motion to Compel after discovery closes (especially where, as here DigitalMojo timely served its discovery on the day discovery had closed).

As to DigitalMojo’s Requests for Admissions specifically<sup>1</sup>, Connect implies, without stating specifically, that DigitalMojo did not request a “meet and confer conference” with Connect when DigitalMojo determined that it was dissatisfied with discovery responses. Page 7 of Connect’s Response, top of page. However, one page earlier in Connect’s Response, Page 6, bottom of page, Connect says:

“As a basis for re-serving the 403 requests for admission in 2014, counsel for Digitalmojo asserted in a letter dated May 3, 2014 that Digitalmojo was dissatisfied with Connect’s previous responses to the same 403 requests, which were originally service by Connect on December 5, 2011.”

DigitalMojo asserts its letter dated May 3, 2014, is a “meet and confer” letter, and counsel for each party discussed the points raised in this letter.

Connect goes on to say:

“Dititalmojo is precluded from seeking relief...because Digitalmojo did not act within a reasonable time after service of Connect’s original responses to the 403 requests in December of 2011.”

However, Connect does not tell us what a “reasonable time after service” is (within which DigitalMojo could file its Motion to Compel), only that DigitalMojo could not have served its responses within that reasonable time. We might recall in this regard that much has occurred in these cases since the December 2011 date which Connect says governs our “reasonable time,” and much of the time has ticked off while the parties (but more often Connect) have filed motions and those motions were pending. These motions include pendency of Connect’s Motion for Summary Judgment, filed October 28, 2011 (as amended). By February 23, 2012 Order of the Board, Proceedings herein were suspended retroactive to August 26, 2011, pending disposition of Connect's corrected motion for partial summary judgment in Opposition No.

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<sup>1</sup> We note here that, while Connect has made much of the number of DigitalMojo’s interrogatories and its requests for admissions, DigitalMojo is not limited to any number of requests for admissions if, as here, they were timely served.

91196299 and Connect's motions to dismiss and the second motions for leave to file amended petitions to cancel in Cancellation Nos. 92054395 and 92054427. Connect's October 28, 2011, Motion for Summary Judgment was not decided until March 21, 2013. In the meantime, Connect opposed DigitalMojo's Amended Petitions to Cancel (March 9, 2012), and those Petitions were amended (October 1, 2012). After the Board's decision on Connect's October 28, 2011, Motion for Summary Judgment, the Board decided Connect's April 18, 2013, motions for partial reconsideration of the Board's March 21 Order, and resumed these cases once again (August 14, 2013). Thus, much of the "two and one half years" period Connect contends is more than a "reasonable time," we were occupied with Connect's motions, during which time these cases have been suspended.

DigitalMojo submits that the circumstances of any single case could, in fact, "restart the clock for determining a "reasonable time," contrary to Connect's suggestion, and this is just such as case. DigitalMojo also submits that, under the circumstances of this case, its re-serving of its Requests for Admissions may be taken as an objection to Connect's responses as originally served. In either case, this Motion to Compel should be granted because of its special circumstances, or DigitalMojo should be granted leave to re-serve its discovery (or serve additional discovery, in the case of its interrogatories).

### **III. CONCLUSION**

DigitalMojo submits that, when all of the forgoing is considered, the Board should grant DigitalMojo's Motion to Compel (or grant it leave to serve additional discovery), or grant DigitalMojo's Motion to Compel in part as appropriate. We note in this regard that DigitalMojo has requested supplemental responses to its discovery requests as served on Connect on March 12 and March 13, 2014, i.e.,:

- a. PETITIONER'S INTERROGATORIES, SET ONE.
- b. PETITIONER'S INTERROGATORIES, SET TWO.
- c. PETITIONER'S REQUESTS FOR ADMISSIONS, SET ONE.
- d. PETITIONER'S REQUESTS FOR ADMISSIONS, SET TWO.

DigitalMojo further requests the Board reset the discovery and trial schedule in these consolidated proceedings as necessary to allow service of these discovery requests (if necessary)

by DigitalMojo, and responses to these requests by Connect, after the Board decides the discovery issues presented in this Motion to Compel.

Date: February 26, 2016



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#### CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this document is today being submitted via electronic filing utilizing the ESTTA system on:

Date: February 26, 2016



Thomas W. Cook

#### CERTIFICATE OF SERVICE

This is to certify that on this date, a true copy of the foregoing

#### **APPLICANT'S/PETITIONER'S REPLY IN SUPPORT OF ITS MOTION TO COMPEL SUPPLEMENTAL RESPONSES**

is being served, by U.S. mail, postage prepaid, addressed to the following:

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Date: February 26, 2016



Thomas W. Cook